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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,992	12/05/2001	Ritsuko Tanaka	1086.1152	2820
21171	7590	07/24/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/001,992	TANAKA ET AL.	
	Examiner Yehdega Retta	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 April 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed April 6, 2006. Applicant amended claims 1, 7, 18, 19, 21, 22, and 23. Claims 1-25 are currently pending.

### ***Requirements for Information***

37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under' 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (I) Commercial databases: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search: Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.
- (v) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.
- (vi) Improvements: Where the claimed invention is an improvement, identification of what is being improved.
- (vii) In Use: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.
- (2) Where an assignee has asserted its right to prosecute pursuant to' 3.71 (a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.
- (3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.
- (b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

- (c) A reply, or a failure to reply, to a requirement for information under this section will be governed by " 1.135 and 1.136.

The Office is requesting submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. *Of particular interest is information on the Internet inserted-bill supplying service "Orikomio" which was described by applicant as a prior art. From the information supplied by applicant in the background of the invention Examiner could not differentiate the claimed invention from the prior art.*

No prior art related to the "Orikomio" was submitted under Information Disclosure Statement. It appears that it would be appropriate to require applicants to provide the information mentioned above which is necessary to ensure a quality examination to be performed by the Office.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, 15, 16 and 18-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Lapstun et al. (US 7,038,797).

Regarding claims 1-4 and 18-25 Lapstun teaches a database, which registers a supplier (publisher) for providing a first service (access to publication or site) and users (registered subscribers, see col. 23 lines 33-42) that have contracts with the supplier (publisher or the site) (see col. 23 lines 9-15, 49-67). Lapstun teaches different publishers providing publication by paying fee for the service which indicates that they are registered (see col. 25 lines 34-46) to

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provide service to subscribers (see col. 27 lines 6-12) and advertisement preparation unit for placing the advertisement on a web page (col. 27 line 55 to col. 28 lines 4, col. 29 lines 33-57); contractor users (subscribers) of the first service (publication) on the database allows the user to view the advertisements on the web page so as to provide a second service; wherein the second service is provided to the user at an independent time (different time from the advertiser entering the advertisement) and by a different medium (printed) for the first service.

Regarding claims 5-13 and 15, Lapstun teaches giving a privilege offered by a newspaper dealer or an advertiser to user viewing the advertisement; making a link to the web page; making access to a web page of the advertiser managed by a newspaper dealer; stores advertisement selection information specified by a user and automatically edits a web page dedicated to the user and storing the resulting data; allowing the user to visit the page (see col. 25 line 3 to col. 26 line 11, col. 27 lines 20-26, col. 31 line 30 to col. 32 line 26).

Regarding claim 16, Lapstun teaches printing the advertisement placed on the web page on paper media and distributing the advertisement (col. 25 line 59 to col. 26 line 12, col. 27 lines 6-47).

Claims 1-8, 15, 16 and 18-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Orikomio (admitted art) see background of applicant's specification.

Regarding claims 1-8, 11-13, 15, 16 and 18-25 Orikomio teaches a database, which registers a supplier (inserted-bill supplying service) for providing a first service (web page) and users that have contracts with the supplier (see applicant's specification page 3); advertisement preparation unit for placing the advertisement on a web page; contractor users (registered users)

of the first service (web page) on the database allows the user to view the advertisements on the web page so as to provide a second service; wherein the second service is provided to the user at an independent time.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. (US 7,038,797) further in view of Fredrickson Pub. No. US 2002/0019768 (hereinafter Fredrickson).

Regarding claim 17, Fredrickson teaches collecting registers visiting information of the user for each advertisement visit and determines and settles publication fee based upon the results of the survey (see 0050, 0065, 0066, 0067 and 0068-0086). It would have been obvious to one of ordinary skill in the art at the time of the invention to include such feature, in Lapstun, in order to charge advertisers based upon the visits, as taught in Fredrickson.

Claim 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. (US 7,038,797) further in view of Official Notice.

Regarding claim 14, Lapstun does not teach preparation of a guide map upon a request from the user. Official Notice is taken that is old and well known in the art of WWW to provide

a preparation of a guide map and to display it. On-line advertisers provide a program such as Mapquest to provide a map of a location, including the current location of the user and the destination specified by the user, in order to find the geographical location of the advertiser. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide such feature, in Lapstun web page, since Internet users use on-line map, such as Mapquest, to find the location of the advertiser providing the advertisement.

Claims 9, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orikomio (admitted art) in view of Lapstun et al. (US 7,038,797).

Regarding claims 9, 10, Lapstun teaches automatically editing a web page dedicated to user based upon advertisement selection information specified by user (col. 27 line 55 to col. 28 lines 4, col. 29 lines 33-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to edit a web page dedicated to user in order to provided targeted ads, as taught in Lapstun.

Regarding claim 14, Orikomio does not teach preparation of a guide map upon a request from the user. Official Notice is taken that is old and well known in the art of WWW to provide a preparation of a guide map and to display it. On-line advertisers provide a program such as Mapquest to provide a map of a location, including the current location of the user and the destination specified by the user, in order to find the geographical location of the advertiser. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide such feature, in Lapstun web page, since Internet users use on-line map, such as Mapquest, to find the location of the advertiser providing the advertisement.

Claim 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orikomio further in view of Fredrickson Pub. No. US 2002/0019768 (hereinafter Fredrickson).

Regarding claim 17, Fredrickson teaches collecting registers visiting information of the user for each advertisement visit and determines and settles publication fee based upon the results of the survey (see 0050, 0065, 0066, 0067 and 0068-0086). It would have been obvious to one of ordinary skill in the art at the time of the invention to include such feature, in Orikomio, in order to charge advertisers based upon the visits, as taught in Fredrickson.

***Response to Arguments***

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Yehdega Retta*  
RETTA YEHDEGA  
PRIMARY EXAMINER

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